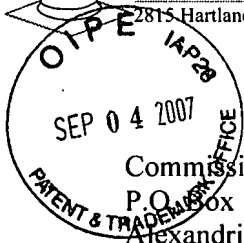




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Date: 9/3/07
Attorney
Docket No: 3117-101

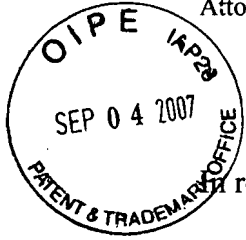
SIR:

Transmitted herewith for filing is the patent application of:
Inventor(s): Nizar Youssef Mehio
Titled: MODULAR SMOKING APPARATUS

Enclosed are:

- ☒ Appeal Brief (in Triplicate)
- ☒ Authorization to Charge Credit Card
- ☒ Small Entity Claim

Attorney of Record: Michael Keith Blankenship
Registration No.: 53,997
CUSTOMER NO. 64275



09-05-07

AF/IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re Application of

Nizar Youssef Mehio

Serial Number: 10/751,119

Filed: Jan. 05, 2004

Title: MODULAR SMOKING
APPARATUS

Examiner: Edel, John B.

Group Art Unit: 1731

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELANT'S BRIEF

This brief is submitted in furtherance of the Notice of Appeal filed on July 2,
2007

The fees required under CFR 1.17 for the filing of this brief are dealt with in the
accompanying TRANSMITTAL OF APPEAL BRIEF document.

This brief is transmitted in triplicate.

This brief contains these items under the following headings and in the order set
forth below:

- I. REAL PARTIES IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF INVENTION
- VI. ISSUES
- VII. GROUPING OF CLAIMS
- VIII. ARGUMENT - REJECTIONS UNDER 35 U.S.C. §§ 102, 103, and 112.
- IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL
- X. APPENDIX OF EVIDENCE
- XI. APPENDIX OF RELATED PROCEEDINGS

The final page of this brief bears the practitioner's signature.

I. REAL PARTY IN INTEREST

The real party in interest of this appeal is Nizar Mehio of the Montana Building:
Tallet El Khayet, Lebanon.

II. RELATED APPEALS AND INTERFERENCES

Applicant believes that no other appeals or interferences will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

The status of the claims in this application is as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims 24, 25, 27-40, and 43-45 are in the application.

B. STATUS OF ALL THE CLAIMS

1. Claims canceled: 1-23, 26, 41, 42, and 46.
2. Claims withdrawn from consideration but not cancelled: None
3. Claims pending: 24, 25, 27, 28-40, and 43-45.
4. Claims allowed: None
5. Claims rejected: 24, 25, 27, 28-40, and 43-45.

C. CLAIMS ON APPEAL

The claims on appeal are claims: 27, 28-40, and 43-45.

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment August 15, 2007, which was rejected as the amended claim 24 was deemed indefinite.

V. SUMMARY OF INVENTION

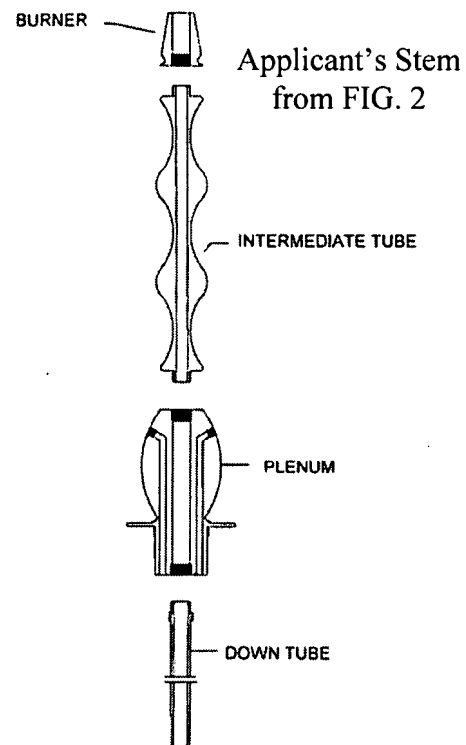
A basic hookah includes a base, a stem, at least one hose with a mouthpiece, and a bowl. The hookah bowl holds the hookah tobacco, frequently “massell.” The heat that ignites the massell originates from small coals positioned in a perforated foil above the hookah bowl. Particulates from the ignited massell travel in the smoke created by the ignition down through an aperture in the hookah bowl into the hookah stem.

The hookah stem is the primary smoke transport component of a hookah and is usually fabricated from decorative materials, such as brass, tin, or stainless steel. The stem transports the dry massell smoke from the burner into the interior of the hookah’s water-bearing base. The stem releases the dry smoke beneath the water line; the massell smoke is cooled by the base water and then emerges from the water line as moistened smoke. The cooled, wetted massell smoke then returns to the stem; though not through the same conduit by which the massell smoke entered the base, but through a separate wet smoke conduit. From the stem, the massell smoke travels through the hose and out of an attached mouthpiece.

The present invention is modular hookah having several aspects. In a first aspect of the invention disclosed in claim 27, the hookah includes a base and a segmented stem with removable components. The segmented stem includes an intermediate tube removably connected to a plenum (See e.g. FIG. 2 and pars. 24 & 25). The plenum further includes external threading that affixes to an internally threaded base, and a down tube for releasing dry smoke into a hookah base (See e.g. FIG. 2 and pars. 25, 26 & 33). Each of these stem segmentations subsumes a specialized function of a traditional hookah stem: the intermediate tube transports the dry smoke to the plenum; the plenum directs

the dry smoke to the base and then receives the smoke again, in wetted-form, in a separate wet smoke aperture to pass to a hookah user.

In a second aspect of the present invention disclosed in claim 36, the hookah includes a threaded base and a segmented stem with threaded connections. At the apex of the segmented stem, a threaded burner is the initial inlet for dry smoke from a hookah bowl. The threaded burner connects via threads to a threaded intermediate tube (See e.g. FIG. 2 and pars. 17 & 24); and the threaded intermediate tube connects via threads to a threaded plenum (See e.g. FIG. 2 and pars. 24 & 25). The



threaded plenum further includes threading that affixes to the threaded base (See e.g. FIG. 2 and pars. 25, 26 & 33), and a down tube for releasing wet smoke into the base. (See e.g. FIG. 2 and par. 15). Each of these stem segmentations subsumes a specialized function of a traditional hookah stem: the burner contacts a hookah bowl attached thereto and receives the dry smoke; the intermediate tube transports the dry smoke to the plenum; the plenum directs the dry smoke to the base and then receives the smoke again, in wetted-form, in a separate wet smoke aperture to pass to a hookah user. (See e.g. FIG. 2 and pars. 24 & 33)

In a third aspect of the invention disclosed in claim 40, the stem is segmented between the intermediate tube and the plenum (See e.g. FIG. 2 and pars. 24 & 25). The

plenum includes threading to allow a threaded connection between it and a base; and the plenum further includes a down tube for releasing dry smoke into a hookah base and wet smoke conducting means for transferring wetted smoke from the base to a hookah user.

(See e.g. FIG. 2 and pars. 24 & 25)

VI. ISSUES

1. Whether claim 24 is obvious over Zahariadis' U.S. Patent No. 1,513,147 in view of the knowledge of one of ordinary skill in the art.
2. Whether claim 36 is obvious in light of the Ganim's U.S. Patent No. 722,405 in view of Kahler's U.S. Patent No. 3,872,872.
3. Whether claim 40 is anticipated by the Zahariadis' U.S. Patent No. 1,513,147 and obvious.
4. Whether the amended claim 24 of the August 15, 2007 amendment is indefinite.

VII. GROUPING OF CLAIMS

Claims 27, 28-40, and 43-45 stand rejected under 35 U.S.C. § 103. The Applicant intends to discuss the rejected claims in three categories: Category A to include claims 27 and 28-35; Category B to include claims 36-39; and Category C to include claims 40, and 43-45.

VIII. ARGUMENTS

A. REJECTION OF CLAIM 24 UNDER 35 U.S.C. 103

Claim 27 was finally rejected as obvious over the Zahariadis U.S. Patent No. 1,513,147, "Tobacco Water Vacuum Pipe" ("Zahariadis"). The Applicant asserts that the Examiner failed to explicitly relate the cited art to Applicant's claimed invention as dictated by the MPEP §2142 prima facie standard of obviousness. *See KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350, 14 (U.S. Apr. 30, 2007) ("...obviousness analysis should be made explicit"). The case of obviousness cannot be supported because (1) all of the claimed limitations of claim 27 are not taught or suggested by the cited art, and (2) the record includes no suggestion or motivation to modify the reference to include all of the limitations of claim 27. *See* M.P.E.P. §2142; Memo from Margaret A. Forarino, Deputy Commissioner USPTO to Technology Center Directors, *Supreme Court decision on KSR Int'l Co., v. Teleflex, Inc.*, page 1 (May 3, 2007).

1. A Distinct, Threaded Plenum is not Present in Zahariadis

In rejecting claim 27, the Examiner asserts that Zahariadis discloses Applicant's plenum in Zahariadis's element 5. *Examiner's Action 4/3/2007*, page 4. This strained assertion is not unexpected in an attempt to characterize a single-piece stem as a multiple-piece stem. Zahariadis's element 5 is packing material; that is to say, compressible padding to prevent the escape of smoke. *Zahariadis*, lines 45-47.

This packing material includes none of the structure of Applicant's plenum as recited in claim 27 and retained from the claims 24 and 26 from which it depends.

Applicant would like to highlight five limitations of Applicant's plenum not found in Zahariadis's packing material:

1. a plenum that "defin[es a]dry smoke aperture" (in fact, it seals to prevent smoke passage) *Claim 27*;
2. a plenum that "defin[es] a wet smoke aperture;" *Claim 27*;
3. a plenum with "an upper end adapted to removably fasten to said lower end of said intermediate tube." *Claim 27*;
4. a plenum with an externally threaded lower end configured to mate with the threaded upper end of the base. *Claim 24* (plenum = lower end of the stem), and *Claim 25* (plenum includes external threading); or
5. a plenum that allows the "down tube...to removabl[y] fasten to [the] plenum." *Claim 27*

Zahariadis's packing material includes none of these five plenum limitations. Although this awkward structural analogy might lead one to believe that the Examiner was mistakenly discussing Zahariadis's element 3 or 1; such cannot be the case, elements 3 and 1 were cited earlier as corresponding to Applicant's claimed intermediate tube and base, respectively. *Examiner's Action 4/3/2007*, pages 2 & 4.

To explain this precarious discovery of the undisclosed structural attributes of Zahariadis's packing material, the Examiner adds in a footnote: "Plenum is interpreted broadly to include such meanings as 'a space filled with matter as opposed to a vacuum.'" *Id.*, page 4 (emphasis mine). Broadly indeed! Merriam Webster, on the other hand, explains that a plenum is "an air-filled space in a structure; especially: one that receives air from a blower for distribution." Merriam Webster's Online Dictionary, <<http://www.m-w.com/dictionary/plenum>>. This less-expansive definition seems more apt, particularly as Applicant's plenum receives dry smoke from the intermediate tube, distributes the dry smoke to the base; and then receives wet smoke from the base, and

then distributes the wet smoke to a user. If the Examiner was unclear as to the meaning of “plenum,” caselaw mandates that the Examiner review the specification, for example in pars. 0003 and 0015, to find that a plenum is “a part of the stem” that includes a “substantially vertical dry smoke aperture...and a wet smoke aperture...” *Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed. Cir. 1985). (“The specification is...the primary basis for construing the claims.”)

In rejecting claim 27, the Examiner cites no sources for his obviousness determination other than the knowledge of one of ordinary skill in the art to rearrange screw threading and the disclosure of Zahariadis. *Examiner’s Action 4/3/2007*, page 4. As Zahariadis does not disclose Applicant’s plenum as affirmatively claimed in claim 27, and there is no record of suggestion or motivation to modify Zahariadis to include Applicant’s plenum, Applicant requests that the Board reverse the Examiner’s obviousness determination and allow claim 27.

2. Conclusion

Zahariadis does not disclose a plenum having any of the multiple limitations of Applicant’s plenum, and there is no record of motivation or suggestion to modify Zahariadis to include any of those multiple limitations. Applicant requests that the Board reverse the Examiner’s rejection and allow claim 27. More particularly, Applicant requests that this Board order entry of Applicant’s August 15th amendment, which incorporated the limitations of claim 27 into claim 24; but did so in a fashion deemed indefinite. For further discussion of this indefiniteness rejection, please see Section VIII.D, *infra*.

B. REJECTION OF CLAIM 36 UNDER 35 U.S.C. 103

Claim 36 was rejected as obvious in light of the Ganim's U.S. Patent No. 722,405 "Smoking Pipe" ("Ganim") in view of Kahler's U.S. Patent No. 3,872,872, "Compact Water Pipe" ("Kahler"). The Applicant asserts that in relying upon the prima facie standard of obviousness of MPEP §2142, the examiner has failed to explicitly relate the cited art to Applicant's claimed invention. *See KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350, 14 (U.S. Apr. 30, 2007) ("...obviousness analysis should be made explicit"). The case of obviousness cannot be supported because (1) all of the claimed limitations of claim 36 are not taught or suggested by the cited art, and (2) the record includes no suggestion or motivation to modify the reference to include all of the claimed limitations of claim 36. *See* M.P.E.P. §2142; Memo from Margaret A. Forarino, Deputy Commissioner USPTO to Technology Center Directors, *Supreme Court decision on KSR Int'l Co., v. Teleflex, Inc.*, page 1 (May 3, 2007).

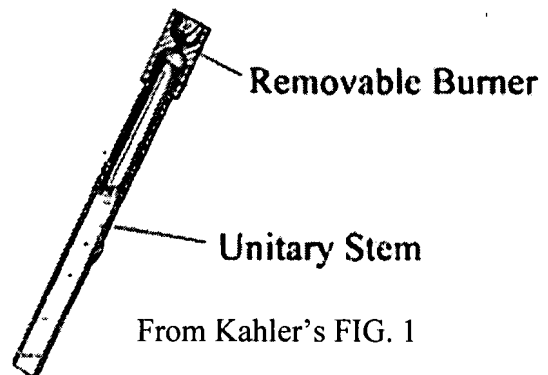
The stem segmented into a distinct plenum and distinct intermediate tube affirmatively recited in Applicant's independent claim 36 cannot be found in either the Ganim or Kahler references, much less with a threaded fastener. Furthermore, there is no suggestion or motivation within the references or the record to undertake any such modification.

1. A Stem with Multiple Segmentations is neither Taught nor Suggested by Kahler or Ganim.

As noted in Applicant's par. 0003, the stem is the conduit that conveys smoke

from a burner to a fluid-filled base and then to a hose. Applicant's claim 36 includes a stem having two distinct and removable portions: "a threaded plenum" and "a threaded intermediate tube," each of which subsumes a portion of the dry smoke aperture. Applicant claims, and both Kahler and Ganim disclose, removable burners. Beneath their burners, however, Kahler and Ganim disclose only unitary stem portions while Applicant further divides his stem into a distinct, removable plenum and a distinct, removable intermediate tube. In Applicant's claim 36, this stem is segmented into an intermediate tube which is purely a dry smoke transport component, and into a plenum that continues the dry smoke transport (*See Claim 36*, "in gaseous communication"), but also includes a distinct wet smoke outlet passage.

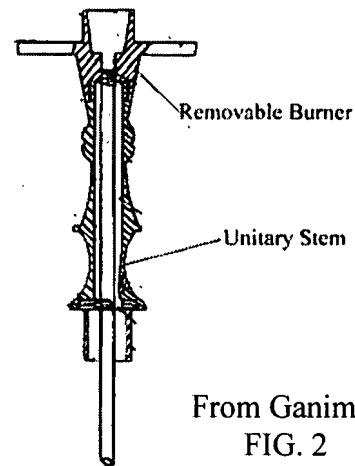
The Kahler reference, although not a hookah, does include a dry smoke transport component (*Kahler*, element 18), which could be considered a hookah stem analog. The Kahler "stem" is positioned between a removable burner (*Id.* element 20) and a fluid-filled base (*Id.* element 15). Kahler



teaches only a unitary stem purely for the purposes of dry smoke transport. No portion of that stem is segmented into two distinct portions, or includes a wet smoke aperture as is an affirmatively claimed limitation of Applicant's plenum.

Ganim teaches a stem (*Ganim*, Fig. 2: element D) with a single segmentation (*Id.* element D³) that allows a distinct, removable burner (*Id.* element F). Although the stem attaches to a removable, interior down tube; the stem itself includes no segmentation that results in a distinct intermediate tube and a distinct plenum. In attempting to find a

threaded plenum that releasably attaches to a threaded intermediate tube, the Examiner directs the Applicant's attention to Ganim's "attachment in Fig. 1." *Examiner's Action 4/3/2007*, pg. 5. However, the attachment of Fig. 1 does not disclose any separation in Ganim's stem that creates a distinct plenum and a distinct intermediate tube.



The Examiner's office actions erroneously characterize elements as having attributes and structure that they do not possess. The Examiner finds "[a] burner" as Ganim's element P in his Fig. 1; a threaded intermediate tube as Ganim's element F in his Fig. 2; and "a threaded plenum" as Ganim's element D in his Fig. 2. *Examiner's Action 4/3/2007*, pg. 5. Ganim's element P is not a burner, but a tobacco bowl (*Ganim*, lines 33-34); element F is not an intermediate tube, but a crown (*Id.* line 31), properly analogous to Applicant's burner; and element D is not a plenum, but is instead a post (*Id.* line 30), which is merely a unitary, specialized stem lacking any dry smoke transport capabilities.

To characterize Ganim's post as Applicant's plenum is structurally and conceptually incorrect. The characterization is structurally incorrect because Applicant's plenum includes a continuation of the hookah dry smoke transport and a wet smoke outlet. Claim 36 explains that the plenum is "in gaseous communication with [the]...intermediate tube," which is in turn "in gaseous communication with [the]...burner." Unlike Applicant's plenum, Ganim's post does not contact the gaseous dry smoke of his burner, it includes only a wet smoke outlet. Assertions equating Ganim's post to Applicant's plenum are further tortured by Applicant's claim 36

limitation that the plenum includes a down tube to release the dry smoke into the hookah base. The Ganim post can never release dry smoke; it never receives any.

Aside from the aforementioned erroneous structural comparisons, the characterization is conceptually incorrect because Ganim's hookah configuration creates a single-member dry smoke transport (*Ganim*, Fig. 1: element H) enclosed within a single-member enclosure having a wet smoke outlet (*Id.* element B⁵ of element D), rather than transversally bifurcating a continuous stem that incorporates both a dry smoke aperture and wet smoke transport aperture. To suggest that Ganim's member-within-member may lead a person of ordinary skill in the art to a member-upon-member design is unsupportable. *Cf. In re Ratti*, 270 F.2d 810, 813 (CCPA 1959)(Rejection was improper when the "combination of references would require a substantial reconstruction and redesign of the elements [within the references] as well as a change in the basic principles under which [a reference] was designed to operate").

Claim 36 recites that both the plenum and the intermediate tube include a portion of the dry smoke aperture of Applicant's stem: "a threaded intermediate tube in gaseous communication with [the burner, which receives dry smoke] and a threaded plenum...in gaseous communication with the intermediate tube...and further having a down tube for releasing dry smoke." Because the Applicant's stem is segmented into multiple dry smoke conduit portions, the Applicant's stem includes the modular qualities recited in the claim preamble, but absent in Ganim.

Ganim's dry smoke conduit member (*Id.* element H) does indeed separate from the body of the hookah (See *Id.* element H¹ of element H). If released, however, the dry smoke conduit would only add to the bulk of toting Ganim's hookah. As is shown by

Applicant's FIGS. 1 - 4, 8 and 9 – and claimed in Applicant's claim 36 – segmenting the stem transverse to the dry smoke aperture allows a hookah stem to disassemble to diminish the stem height. Hookah height is the prime inhibitor of portability, and simplified hookah transportation is a central aspect of the present invention as noted in Applicant's paragraph 0004. Unlike the releasable stem portions of Applicant's hookah, the releasable nature of Ganim's dry smoke member decreases the longitudinal bulk of his hookah not one iota.

As both Kahler and Ganim disclose only unitary stems and Applicant claims a stem with a distinct and separable plenum and intermediate tube each defining a portion of the dry smoke conduit, Applicant requests that this Board overrule the Examiner's rejection of claim 36.

2. The Record Contains No Suggestion or Motivation in the References or Otherwise to Modify the Disclosed References to Include a Distinct Plenum.

In twice rejecting the Applicant's patent claim 36, Examiner never cites any suggestion or motivation within the art to segment a hookah stem into a distinct plenum and a distinct intermediate tube. In a separate rejection of claim 27 relating to a separable down tube, Examiner asserted that "it would be obvious to further segment the components...of Ganim using threaded connections for...releasable attachment because doing so would allow easier cleaning of the Ganim hookah." *Examiner's Action 10/10/06*, page 5. This rationale would certainly not apply to segmenting Ganim's stem for cleaning purposes.

Further segmenting the Ganim stem would not allow easier cleaning because the

elongate down tube (*Ganim*, element H¹) of the *Ganim* hookah allows dry smoke to completely bypass the interior of the *Ganim* stem (*Ganim*, element D). Dry smoke from the *Ganim* hookah is funneled to the base in a manner that avoids the entire interior of the *Ganim* stem; thus, the interior of the *Ganim* stem would not accumulate dry smoke residue and not require cleaning. Applicant suggests that there would be no motivation to clean a component that does not require cleaning.

In seeking motivation to alter the *Ganim* hookah stem to create a removable peripheral down tube, a person of ordinary skill in the hookah manufacturing art would not turn to the Kahler water pipe reference to create a segmentable stem for cleaning purposes. Instead of the teaching one of ordinary skill in the art that a segmented stem would assist in cleaning, the Kahler reference teaches that a unitary stem is the path towards a cleaner water pipe; he explains in his patent that “it will be apparent that the smoking device [of his FIG. 1] is quite simple to maintain and keep clean.” *See Kahler*, col. 3, lines 40-42.

In examining the device of Kahler’s figure 1, it can be seen that the member for delivering dry smoke is a single, unitary dry smoke member (*Kahler*, Fig. 1, element 18). Rather than finding motivation, one would only find a discouraging attitude in Kahler towards further segmenting components as he explicitly discourages alterations that would result in pipes “complicated in their construction.” *Id.*, col. 1, lines 17-18. Kahler clearly strives to simplify maintenance through minimizing structure into few, large components; while the Applicant seeks to enhance the usability of hookahs through modularization, i.e. increasing structure with multiple, small components.

3. Conclusion

In addition to the aforementioned portability and cleaning aspects of a segmented stem; there is, Applicant has discovered, a significant economic consequence to having a distinct plenum connected to a distinct intermediate tube. The typical hookah includes both a dry smoke inlet and the wet smoke outlet in a single, unitary stem. Stems corrode; or more particularly, the portion of the stem in contact with wet smoke corrodes quicker than portions of the stem merely contacting dry smoke. Because Applicant's plenum as claimed in claim 36 is the *sole* bearer of the wet smoke outlet, a hookah user having a corroded wet smoke outlet need only change the plenum rather than the entire hookah stem. As hookahs can be decorative and fabricated of expensive materials; replacing small rather than large components is a substantial improvement in the art.

Neither Ganim nor Kahler disclose a stem having any transverse segmentation, much less a threaded intermediate tube and threaded plenum. Furthermore, no rejection has cited any explicit reason, motivation, or suggestion to alter their devices to create a bifurcated stem structure.

C. REJECTION OF CLAIM 40 UNDER 35 U.S.C. 102

Claim 40 was rejected as anticipated over the Zahariadis U.S. Patent No. 1,513,147, "Tobacco Water Vacuum Pipe" ("Zahariadis"). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinefabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)(emphasis added). Applicant discerns at least two differences between the Zahariadis device and the claimed

hookah of the Applicant: (1) a releasable, threaded intermediate tube, and (2) a releasable, threaded plenum.

1. A Distinct, Threaded Intermediate Tube is not Present in Zahariadis

Claim 40 claims a threaded intermediate tube that releasably attaches to a plenum. Zahariadis does not disclose a threaded, releasable intermediate tube. In attempting to find an intermediate tube as disclosed by Applicant, the Examiner points to the tobacco bowl of Zahariadas. *Examiner's Action 4/3/2007*, page 3; and see e.g. *Zahariadas*, Fig. 1: element 6. The tobacco bowl of Zahariadas, or any other hookah tobacco bowl, bears no structural similarities to the dry smoke transport structure and functions of the Applicant's intermediate tube. Applicant discloses a tobacco bowl, but does not claim it. The Applicant does, however, explicitly claim an intermediate tube, which Applicant's disclosure defines as a dry smoke transport between the tobacco burning container and the base. See e.g. Applicant's par. 024 ("... intermediate tube 110, dry smoke aperture 104, and down tube 108 form a conduit 118 through which dry smoke 196 may travel from burner 112 to base 114."). Zahariadis does not disclose an intermediate tube; an intermediate tube as claimed by Applicant would require a segmented stem, and Zahariadis merely discloses a unitary stem.

2. A Distinct, Threaded Plenum is not Present in Zahariadis

Claim 40 claims a threaded plenum that releasably attaches to an intermediate tube. Zahariadis does not disclose a threaded plenum. In attempting to find a plenum as disclosed by Applicant, the Examiner points to the hollow member of Zahariadas.

Examiner's Action 4/3/2007, page 3; and *See e.g. Zahariadas*, Fig. 1: element 18. The Applicant's plenum has clear structural, functional, and configuration differences from the hollow member of Zahariadas. Most importantly, the hollow member of Zahariadis is a conduit only configured to allow the transport of wet smoke. *Zahariadis*, see e.g. Fig. 1, (smoke direction arrows). Applicant's plenum is a conduit for both dry smoke from the intermediate tube and wet smoke from the base; claim 40 explicitly dictates such structure:

a threaded plenum, releasably attached in gaseous communication with said intermediate tube...and wet smoke conducting means, disposed within said plenum and in gaseous communication with said base, for accepting and conducting wet smoke from said base.

Applicant's Claim 40. Because Applicant's plenum includes two smoke pathways, one wet and one dry; and the hollow member of Zahariadis includes only a wet smoke conduit, it does not include all of the limitations of claim 40. Zahariadis' hollow member is not Applicant's plenum; nor does Zahariadis disclose a threaded, releasable plenum. Zahariadis, as the other cited references, includes a unitary stem that does not include segmentations.

3. Zahariadis and Obviousness Concerns

In addition to lacking the modular components of Applicant's claim 40, the teachings of the uncovered references would not motivate a person of ordinary skill in the art to create the modular hookah of Applicant's claim 40. Note the squat nature of the Zahariadis stem (*Zahariadis*, Fig. 1: element 3), which is necessitated by the primary importance of his invention: ushering smoke particles away from the base liquid.

In the member 3, below the container 6 is a chamber 11, designed for the arrest

and retention of particles which it may be desired to keep out of liquid 2. The chamber 11 may be divided into two or more parts, two being shown in [Fig. 1]. This division, in the case illustrated, is effected by a web 12, having marginal flanges 13 to position it, and perforated, as at 14, for the passage of smoke.

Zahariadis, lines 55-64. Thus, an elongate stem would increase the distance between the web and the down tube, element 15, and diminish the angle between the entry of the down tube and the flanges, which would increase the amount of dry smoke residue capable of entering the down tube. Dry smoke residue capable of entering the down tube entry would be contrary to the purpose of the *Zahariadis* teaching. There is no motivation to lengthen a structure with functionality that diminishes as its length increases; and there is consequently no motivation to modularize already squat components into even smaller sub-portions.

4. Conclusion

Zahariadis does not disclose a stem having any segmentation, much less a threaded, releasable intermediate tube and threaded, releasable plenum. Furthermore, no rejection has cited any explicit reason, motivation, or suggestion to alter *Zahariadis* to create a bifurcated stem structure.

D. INDEFINITENESS REJECTION OF NEWLY-AMENDED CLAIM 24

1. The Newly-Amended Claim 24 is Definite.

In attempting to place the claims of this application in better form for review by this Board, Applicant submitted an amendment on August 15, 2007. This amendment canceled claims 26 and 27 and incorporated their limitations into claim 24. Structurally this amendment clarified the stem as composed of the plenum and intermediate tube; stylistically this amendment excised the inherent redundancies in discussing a component

and then its components which constitute that component.

The Examiner related to Applicant a single flaw: the new claim description was indefinite according to 35 U.S.C. §112, par. 2. He explained, “the proposed claim language makes it unclear what is ‘dimensioned to substantially penetrate’ and what is ‘dimensioned to removably fasten.’” *Examiner’s Action 8/24/2007*, page 2. Applicant reproduces the limitations below:

wherein said stem terminates in a selectively releasable peripheral down tube, defining said dry smoke aperture, dimensioned to substantially penetrate said base and dimensioned to removably fasten to said plenum.

Proposed Claim 24, *Applicant’s Amendment of 8/15/2007*. Through a simple grammatical reading of this claim 24, the limitations include the clarity necessary to satisfy 35 U.S.C. §112, par. 2.

A definite claim is one that when read in light of the specification reasonably apprises one of ordinary skill in the art the scope of the invention. *Howmedica Osteonics Corp. v. Tranquil Prospects, Ltd.*, 401 F.3d 1367, 1371 (Fed. Cir. 2005). The disputed limitation of claim 24 begins by recalling the stem from a previous claim reference. Claim 24 concludes this independent clause by describing the stem as terminating in a peripheral down tube. Upon concluding the independent clause, there follows one parenthetic followed by two dependent clauses, all of which modify down tube.

Even if the grammatical meaning of this claim section was facially unclear: a reading of par. 003, line 15 of the specification would have indicated that the down tube substantially penetrates the base; and a glance at FIGS. 1 – 4, 8 and 9 reveals the down tube as removably fastening to the plenum.

Claim 24 as amended in Applicant’s August 15, 2007 amendment is definite, and

Applicant urges this Board to order its entry as part of its final judgment.

2. Rejection Statements Relating to Unmentioned Defects Ought to be Without Effect.

The Examiner in his August 24, 2007 rejection of Applicant's proposed amendment, asserted that the amendment "raise[d] new issues for consideration" and then proceeded to list the single rejection discussed in Section VIII.D(1), *supra*. *Examiner's Action 8/24/2007*, page 2. The holdings of the Federal Circuit and this Board do not permit such blanket rejections. This Board should disregard any statements of rejections not placed on the record.

The patent examination process is a highly detailed, specialized process between two parties: the applicant(s) and the examiner(s). In reaching a compromise regarding patentability, both parties comment fully on the record in order to attain the highest degree of efficiency in prosecuting an application. *Cf.* M.P.E.P § 706 ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.") Prosecution of a patent application is a costly and time-consuming ordeal for a patent applicant; partial rejections and secret evidence would serve only to increase the time and expense of the patent process. A thorough record is more than a good idea, it is mandatory under the Administrative Procedure Act. *See generally* 5 U.S.C. § 500 *et seq.*

Prompt notice shall be given of the denial in whole or in part of a written application, petition, or other request of an interested person made in connection with any agency proceeding. Except in affirming a prior denial or when the denial is self-explanatory, the notice shall be accompanied by a brief statement of the grounds for denial.

5 U.S.C. § 555(e). Generally speaking, each response (e.g. an amendment) to a rejection is in effect a request to this agency to allow a patent claim, and therefore merits a statement of grounds for denial. Although the Title 5 permits truncations in statements, there is no justification for a truncation of grounds for denial.

Subsection 555(e) of Title 5 does not require a statement of grounds for denial for self-explanatory rejections, and prior denial affirmations. Consolidating claims 24, 25, and 27 into a single claim 24 had not been previously attempted; and these additional secret grounds are certainly not self-evident. This precedent of this Board clearly prohibits, and overturns, rejections lacking support. *E.g. Ex parte Blanc*, 13 U.S.P.Q.2d 1383, 1384-85 (B.P.A.I. 1989)(“By setting forth such a broad brush statement and by failing to explain with a reasonable degree of specificity any one rejection, the examiner has failed, procedurally to establish a prima facie case of obviousness.”) Federal Circuit case law supported the rationale of disregarding undisclosed grounds in *Paperless Accounting, Inc. v. Bay Area Rapid Transit Sys.* 804 F.2d 659, 663 (Fed. Cir. 1986), citing *Ex parte Martin* 104 USPQ 124, 128 (Supr. Exmr. 1952). Rejections not made are not considered. *Id.*

Secret rejections and objections are fundamentally unfair; their presence forces unfocused and perhaps unnecessary responses from the applicant. “The examiner cannot sit mum, leaving the applicant to shoot arrows in the dark hoping to somehow hit a secret objection harbored by the examiner. “*In re Oetiker*, 997 F.2d 1443, 1449 (Fed. Cir. 1992)(Plager, J., concurring). “The ‘prima facie’ case notion...was intended to leave no doubt among examiners that they must state clearly and specifically any objections to patentability, and give the applicant fair opportunity to meet those objections with

evidence and argument.” *Id.*

The Examiner’s response in this particular instance does not appear to be the result of any meaningful agency review. In the event that this Board agrees with Applicant’s arguments of Sections VIII.A and VIII.D(1), Applicant respectfully requests that this Board enter the August 15, 2007 amendment with its amended claim 24 “as is.” This measure would prevent the devastating effects of prolonging this prosecution for Applicant, if upon a hypothetical remand, the Examiner asserted issues left unmentioned in his rejection of August 24, 2007.

3. Conclusion

Claim 24, in its amended state of the August 15, 2007 amendment, is definite. The limitations are grammatically clear, and that clarity is reinforced upon reviewing the specification. Applicant is puzzled by the nature and terseness of the August 24, 2007 rejection prohibiting Applicant’s amendment, and requests that this Board enter the August 15, 2007 amendment in its entirety.

IX. APPENDIX OF CLAIMS

1-23 (Cancelled).

24. A modular hookah comprising:

a base, dimensioned to contain a substantial amount of fluid, with a threaded upper end for receiving dry smoke; and

a stem, having a threaded lower end configured to mate with said threaded upper end of said base, terminating in a selectively releasable peripheral down tube dimensioned to substantially penetrate said base, said stem defining a dry smoke aperture oriented to conduct dry smoke into said base and a wet smoke aperture oriented to accept wet smoke from said base.

25. The modular hookah of claim 24 wherein said threaded upper end of said base comprises internal threading, and said threaded lower end of said stem comprises external threading.

26 (cancelled).

27. The modular hookah of claim 25 wherein said stem comprises:

an intermediate tube, having an upper end and a lower end, defining said dry smoke aperture;

a plenum further defining said dry smoke aperture and defining said wet smoke aperture, said plenum having an upper end adapted to removably fasten to said lower end of said intermediate tube; and

wherein said down tube has an upper end adapted to removably fasten to said plenum.

28. The modular hookah of claim 27 further comprising an intermediate tube

upper cap in releasable attachment to both said intermediate tube and said burner.

29. The modular hookah of claim 28 further comprising an intermediate tube lower cap in releasable attachment to both said intermediate tube and said plenum.

30. The modular hookah of claim 29 further comprising an intermediate tube cover dimensioned to house said intermediate tube.

31. The modular hookah of claim 27 wherein said intermediate tube is adapted to threadably fasten to said plenum and said plenum is adapted to threadably fasten with both said down tube and said base.

32. The modular hookah of claim 31 further comprising a burner adapted to removably fasten to said intermediate tube.

33. The modular hookah of claim 32 wherein said burner is adapted to threadably fasten to said intermediate tube.

34. The modular hookah of claim 24 wherein said stem further defines a pressure release aperture selectively obstructed by a pressure release valve.

35. The modular hookah of claim 34 wherein said pressure release valve includes a threaded connection for releasably affixing to said stem.

36. A modular hookah comprising:

a threaded burner for accepting dry smoke,

a threaded intermediate tube, releasably attached in gaseous communication with said threaded burner;

a threaded plenum, releasably attached in gaseous communication with said

threaded intermediate tube, defining a wet smoke aperture for releasing wetted smoke to a user and further having a down tube for releasing dry smoke; and

a threaded base, releasably attached in gaseous communication with said plenum, dimensioned to contain a substantial amount of fluid for receiving and wetting dry smoke.

37. The modular hookah of claim 36 wherein said down tube is a threaded down tube, in gaseous communication with said plenum, releasably attached to said threaded plenum.

38. The modular hookah of claim 37 wherein said plenum further defines a pressure release aperture, in gaseous communication with said base, selectively obstructed by a pressure release valve.

39. The modular hookah of claim 34 wherein said pressure release valve is a threaded pressure release valve having a threaded connection for releasable attachment to said plenum.

40. A modular hookah comprising:

a base with a threaded connection for receiving dry smoke and dimensioned to

contain a substantial amount of fluid;

an intermediate tube with a threaded connection;

a threaded plenum, releasably attached in gaseous communication with said

intermediate tube, having a down tube for releasing dry smoke into said base;

and

wet smoke conducting means, disposed within said plenum and in gaseous

communication with said base, for accepting and conducting wet smoke from

said base.

41 (cancelled).

42 (cancelled).

43. The modular hookah of claim 40 wherein said dry smoke means further comprises a separable down tube with a threaded connection adapted to releasable attach said separable down tube to said threaded plenum.

44. The modular hookah of claim 40 further comprising pressure stabilizing means in gaseous communication with said base.

45. The modular hookah of claim 40 further comprising cover means adapted to house a substantial portion of said dry smoke conducting means.

46 (cancelled).

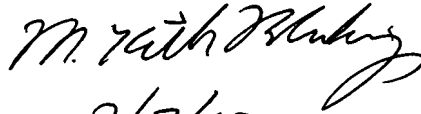
X. APPENDIX OF EVIDENCE

(None).

XI. APPENDIX OF RELATED PROCEEDINGS

(None).

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "M. Keith Blankenship", written in a cursive style.

Date: 9/3/07

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